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113,625

TTAB

Serial No. 75/346908
Mark: INNOVENTIONS INC.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: INNOVENTIONS, INC.

Serial No.: 75/346908

Filed: August 26, 1997

Mark: INNOVENTIONS INC.

Class: 9

Atty. Docket No.: INI 0107 TUS

113,623



02-25-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #22

REQUEST FOR AMENDMENT TO IDENTIFICATION OF GOODS

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Pursuant to a Settlement Agreement entered into between the Applicant and third party opposers (copy attached as Exhibit A - see Paragraph 3.1), Applicant hereby requests that the description of goods for this application be amended as follows:

**MEDICAL APPARATUS, NAMELY, ELECTRONIC
MAGNIFIER, COMPRISING A CAMERA UNIT, VIDEO
PROCESSOR AND A PORTABLE MONITOR OR
HEAD-MOUNT DISPLAY, USED AS A READING AID
FOR INDIVIDUALS WITH LOW OR IMPAIRED VISION
CONDITIONS, in International Class 10.**

Applicant seeks to add the words "MEDICAL APPARATUS, NAMELY," to the existing description, and place the application in "International Class 10".

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513:

February 18, 2002
Date of Deposit

Mark A. Cantor
Name of Person Signing

Signature

9

Applicant respectfully requests entry of the above Amendment.

Upon entry of this Amendment, the application should be in condition for allowance, and such allowance is respectfully requested.

If the Examiner has any questions regarding the above, he is requested to contact the undersigned attorney.

Respectfully Submitted,

INNOVENTIONS, INC.

BROOKS & KUSHMAN P.C.

By: 

Mark A. Cantor
Attorneys for Registrant
1000 Town Center, 22nd Floor
Southfield, Michigan 48075
(248) 358-4400

Dated: February 18, 2002

COPY

SETTLEMENT AGREEMENT

This Settlement Agreement (the "Agreement") is made and entered into by and between Innoventions, Inc. ("Plaintiff"), a Texas corporation with a principal place of business at 10425 Bissonnet, Houston, Texas 77099, and Innoventions, Inc. ("Defendant"), a Colorado corporation with a principal place of business at 5921 South Middlefield Road, Suite 102, Littleton, Colorado 80123-2877, to be effective May 1, 2000.

WHEREAS, a dispute arose between Plaintiff and Defendant regarding Defendant's use and registration of the domain name INNOVENTIONS.COM on the Internet and in connection with the use and federal registration of its mark INNOVENTIONS, INC. for its magnifier products for individuals with low or impaired vision conditions.

WHEREAS, as a result of such dispute, litigation was instituted by Plaintiff against Defendant in the United States District Court for the Southern District of Texas, Houston Division, styled *Innoventions, Inc. v. Innoventions, Inc.*; Civil Action No. H-96-3437, and was dismissed by the Court on February 17, 1998;

WHEREAS, litigation was again instituted by Plaintiff against Defendant in the United States District Court for the Southern District of Texas, Southern Division, styled *Innoventions, Inc. v. Innoventions, Inc.*, Civil Action No. H-99-0782 (the "Lawsuit"), and a trial commenced on April 11, 2000 before the Honorable Calvin Botley;

WHEREAS, Plaintiff and Defendant desire to buy peace, to avoid further uncertainty and expense in the Lawsuit, and to settle the claims asserted in the Lawsuit;

NOW, THEREFORE, in consideration of the mutual covenants, promises, representations, and warranties contained herein, and pursuant to the settlement terms agreed to by the parties on

the record before the Honorable Calvin Botley on April 13, 2000, Plaintiff and Defendant agree as follows:

1 Use of INNOVENTIONS, INC. by Defendant

- 1.1 Plaintiff hereby agrees, consents to, and will not object to, Defendant's use of INNOVENTIONS, INC., a Colorado corporation, as Defendant's corporate name.
- 1.2 Plaintiff further agrees, consents to, and will not object to Defendant's use of its name and mark INNOVENTIONS, INC. in connection with Defendant's medical device products, whether or not they may be connected to a computer or computer monitor.
- 1.3 Plaintiff further agrees to Defendant's registration of its mark INNOVENTIONS, INC. in the U.S. Patent and Trademark Office as provided below.

2 Transfer of Domain Name INNOVENTIONS.COM

- 2.1 Defendant agrees to the court-ordered release of the Internet domain name INNOVENTIONS.COM which is currently in the Registry of the Court and further order by the court to transfer the Internet domain name INNOVENTIONS.COM to Plaintiff.
- 2.2 Defendant and Plaintiff agree, upon execution of this Agreement, in good faith to cooperate with each other, and their respective agents, with respect to the transfer of the INNOVENTIONS.COM domain name, and Defendant specifically agrees, upon execution of this Agreement, to provide whatever assistance is reasonably necessary for InterNIC or Network Solutions, Inc. or any other body to transfer ownership and registration of the domain name INNOVENTIONS.COM to

Plaintiff, including preparing and executing necessary domain name transfer forms or other documentation that may be required to be submitted to InterNIC or Network Solutions, Inc., or any other designated body.

2.3 The parties agree that for ninety (90) days after the domain names INNOVENTIONS.COM, INNOVENTIONSINC.COM, and INNOVENTIONS-INC.COM become operational by the transferee, the transferee will cause the currently existing and operating e-mail addresses of the transferor to be forwarded to transferor's new e-mail address. The parties will, within ten (10) days of execution of this Agreement, provide each other with a list of e-mail addresses to be forwarded.

2.4 Plaintiff is not required under the terms of the Settlement Agreement to post a link to any web site referring or relating to Innoventions, Inc., a Colorado corporation, or its products.

3 Amendment of U.S. Trademark Application Serial No. 75/346,908 and U.S. Trademark Registration No. 2,233,451

3.1 Defendant shall file an amendment of its pending U.S. trademark application for the mark INNOVENTIONS, INC., the subject of Serial No. 75/346,908, seeking registration of its electronic magnifier as a medical device in International Class 10. If the U.S. Patent and Trademark Office does not permit the requested amendment, then Defendant shall have the right to register or attempt to register its mark INNOVENTIONS, INC. or variations thereof which contain INNOVENTIONS, INC. with the U.S. Patent and Trademark Office for its electronic magnifier as a

medical device in International Class 10, and Plaintiff will not oppose such an application. If Defendant is unable to register its mark in Class 10, it will withdraw its mark from Class 9.

3.2 Defendant shall file an amendment of its U.S. trademark registration for the mark MAGNI-CAM, the subject of Registration No. 2,233,451, seeking to cover its electronic magnifier as a medical device in International Class 10. If the U.S. Patent and Trademark Office does not permit the requested amendment, then Defendant shall have the right to register or attempt to register its mark MAGNI-CAM or variations thereof with the U.S. Patent and Trademark Office for its electronic magnifier as a medical device in International Class 10, and Plaintiff will not oppose such an application. If Defendant is successful in having its MAGNI-CAM trademark issued in International Class 10, Defendant agrees to withdraw its existing MAGNI-CAM trademark from International Class 9 at that time. If Defendant is not successful in obtaining registration for MAGNI-CAM in International Class 10, it shall not be required to withdraw its MAGNI-CAM trademark in International Class 9.

3.3 Upon execution of this Agreement, Plaintiff shall file a written withdrawal of Opposition No. 113,625 against U.S. Serial No. 75,346,908, currently pending in the U.S. Trademark Trial and Appeal Board.

3.4 Further, upon execution of this Agreement, Plaintiff shall cause the withdrawal of Opposition Nos. 113,623 and 113,624, currently pending in the U.S. Trademark Trial and Appeal Board.

4 Payment by Plaintiff

In consideration of this Agreement, Plaintiff agrees to pay to Defendant the settlement amount of Fifty Thousand Dollars (\$50,000.00), Twenty-Five Thousand Dollars (\$25,000.00) on May 1, 2000 and Twenty-Five Thousand Dollars (\$25,000.00) on August 1, 2000.

5 Transfer of Domain Names INNOVENTIONSINC.COM and INNOVENTIONS-INC.COM

- 5.1 Plaintiff agrees to, and hereby does, transfer all of its rights, title and interest in, without any restraints, to the domain names INNOVENTIONSINC.COM and INNOVENTIONS-INC.COM.
- 5.2 Defendant and Plaintiff agree, upon execution of this Agreement, in good faith to cooperate with each other, and their respective agents, with respect to the transfer of the INNOVENTIONSINC.COM and INNOVENTIONS-INC.COM domain names, and Plaintiff specifically agrees, upon execution of this Agreement, to provide whatever assistance is reasonably necessary for InterNIC or Network Solutions, Inc. or any other designated body to transfer ownership and registration of the domain name INNOVENTIONSINC.COM and INNOVENTIONS-INC.COM to Defendant, including preparing and executing necessary domain name transfer forms or other documentation that may be required to be submitted to InterNIC or Network Solutions, Inc. or any other designated body.
- 5.3 Defendant is not required under the terms of the Settlement Agreement to post a link to any web site referring or relating to Innoventions, Inc., a Texas corporation, or its products.

6 No Admission by the Parties

This Agreement is entered into for the purpose of resolving the contested disputes in the Lawsuit, to buy peace between Plaintiff and Defendant, and to avoid further uncertainty and expense in the Lawsuit. The fact that Plaintiff and Defendant have entered into this Agreement does not constitute an admission by any of the parties with respect to the allegations, charges, claims, demands and causes of action asserted.

7 Releases

7.1 Plaintiff does hereby release, acquit and forever discharge Defendant, all successors and each of Defendant's respective stockholders, directors, officers, employees, agents, representatives and attorneys from and against any and all costs, liabilities, payments, damages, penalties, claims, demands, or causes of action of any and every character, kind and nature whatsoever, in law or in equity, for damages or injunctive relief, whether arising out of the law of contracts, torts, or otherwise, under statutory law or common law whether known or unknown, suspected or unsuspected, contingent or fixed, accrued or unaccrued, past, present, or future, in whole or in part arising out of, resulting from, based upon, or in any way relating to the allegations made in the Lawsuit. Provided, however, that Plaintiff does not release Defendant from any claim or cause of action that may arise in the future in the event that Defendant uses the mark INNOVENTIONS in connection with a good or service that is likely to cause confusion, mistake, or deception. Plaintiff acknowledges that Defendant's present line of medical devices and future medical devices, whether or not they are capable of being connected to

a computer or a computer monitor, do not violate any trademark rights of Plaintiff, and this release applies to said existing or future products.

7.2 Defendant does hereby release, acquit and forever discharge Plaintiff, all successors and each of Plaintiff's respective stockholders, directors, officers, employees, agents, representatives, and attorneys from and against any and all costs, liabilities, payments, damages, penalties, claims, demands, or causes of action of any and every character, kind and nature whatsoever, in law or in equity, for damages or injunctive relief, whether arising out of the law of contracts, torts or otherwise, under statutory or common law whether known or unknown, suspected or unsuspected, contingent or fixed, accrued or unaccrued, past, present, or future, in whole or in part, arising out of, resulting from, based upon, or in any way relating to the allegations made in the Lawsuit. Provided, however, that Defendant does not release Plaintiff from any claim or cause of action that may arise in the future in the event that Plaintiff uses the mark INNOVENTIONS in connection with a good or service that is likely to cause confusion, mistake, or deception. Defendant acknowledges that Plaintiff's present line of computer products, future computer memory testing devices, optical inspection devices for computer memory and Plaintiff's new Gyroview™ products, do not violate any trademark rights of Defendant, and this release applies to said products.

7.3 Plaintiff and Defendant agree that nothing in this Agreement shall be construed to effect a release of any claims solely for contribution and/or indemnity they may have against each other arising solely out of claims that may be asserted in the

future by a third party. Plaintiff and Defendant warrant and represent to each other that, as of the date of this Agreement, each of them is unaware of any such third party claims, either pending, asserted or threatened.

8 Representation by the Parties

8.1 Plaintiff represents and warrants to Defendant that (a) Plaintiff has full authority to enter into this Agreement; (b) Plaintiff is the sole owner of all property, claims, demands, and causes of action released by Plaintiff under this Agreement and is aware of no claims against same; and (c) no interest in any claims, demands or causes of action released by Plaintiff under this Agreement has been assigned to any other person or entity.

8.2 Defendant represents and warrants to Plaintiff that (a) Defendant has full authority to enter into this Agreement; (b) Defendant is the sole owner of all property, claims, demands and causes of action released by Defendant under this Agreement and is aware of no claims against same; and (c) no interest in any claims, demands or causes of action released by Defendant under this Agreement has been assigned to any other person or entity.

8.3 The signatories to this Agreement represent that they are fully authorized to sign for and on behalf of the entities they represent and in the capacity stated.

9 Miscellaneous

9.1 This Agreement and the rights, obligations and covenants contained herein shall inure to the benefit of and be binding upon each party and beneficiary hereto and

their respective parent corporations, subsidiaries, affiliates, controlled and related entities, successors, heirs, legal representatives, and assigns.

- 9.2 This Agreement constitutes the entire agreement between the parties hereto and supersedes all prior oral and written understandings and agreements between the parties hereto. The provisions of this Agreement shall not be waived, modified, or amended except by subsequent writing signed by all parties to this Agreement.
- 9.3 In the unlikely event that one or more of the provisions contained in this Agreement shall be held to be invalid, illegal or unenforceable in any respect, such invalidity, illegality or unenforceability shall not affect any other provision, and this Agreement shall be construed as if such invalid, illegal or unenforceable provision did not exist.
- 9.4 This Agreement may be executed in separate counterparts and shall be deemed fully executed when each party whose signature is required has signed at least one counterpart, even though no one counterpart contains the signatures of all of the parties. Each counterpart shall be deemed an original, and all counterparts shall constitute but one and the same agreement. Individually signed signature pages may be attached to the body of this Agreement to form a complete agreement.
- 9.5 The Court shall retain jurisdiction to enforce the terms of this Settlement Agreement.

IN WITNESS WHEREOF, this Agreement is executed in multiple counterparts on the
dates attested by the signatories hereto.

INNOVENTIONS, INC. ("PLAINTIFF")

INNOVENTIONS, INC. ("DEFENDANT")

By: D. Lunt

Title: PRESIDENT

Dated: APRIL 28 2000

By: Edward P. Fittman

Title: PRESIDENT

Dated: APRIL 26 2000